SUPREME COURT, U.S.
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No. 01-240

IN THE

Supreme Court of the United States

ROBOTIC VISION SYSTEMS, INC.,

Petitioner,

v.

VIEW ENGINEERING, INC. and
GENERAL SCANNING, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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RESPONDENTS' STATEMENT OF THE QUESTION PRESENTED

Whether one co-inventor's uncorroborated testimony that he did not know whether his invention would be commercially feasible, alone, prevents a court from finding the invention is ready for patenting.

Petitioner says yes; Respondents say no.

STATEMENT PURSUANT TO RULE 29.6

Respondents View Engineering, Inc. and General Scanning, Inc. are both wholly owned subsidiaries of GSI Lumonics, Inc., which is a publicly held company.

TABLE OF CONTENTS

	Page
Respondents' Statement of the Question Presented ..	i
Statement Pursuant to Rule 29.6	ii
Table of Contents	iii
Table of Cited Authorities	v
Statement of the Case	1
Reasons for Denying the Writ	8
A. The Federal Circuit Correctly Applied The "Ready For Patenting" Test Of *Pfaff*	8
B. RVSI Proposes A Subjective Application Of The "Ready For Patenting" Test That Would Eviscerate The Test And Eliminate The On-Sale Bar As A Defense	10
C. RVSI's Arguments In Support Of A Subjective, Inventor-Testimony Based Standard For "Ready For Patenting" Are Not Supported By The Law Nor The Record ...	17
1. The Federal Circuit's Rejection Of One Co-Inventor's Unsupported Testimony On Skepticism Does Not Conflict With The Utility Requirement	18

Contents

Page

2. The Federal Circuit's Rejection Of One Co-Inventor's Unsupported Testimony On Skepticism Does Not Conflict With The Enablement Requirement 21

Conclusion 23

TABLE OF CITED AUTHORITIES

Page

Cases:

D.L. Auld Co. v. Chroma Graphics Corp., 714 F.2d 1144 (Fed. Cir. 1983) 13, 16

Eaton v. Evans, 204 F.3d 1094 (Fed. Cir. 2000) ... 16

Elizabeth v. American Nicholson Pavement Co., 97 U.S. 126 (1877) 15

Estee Lauder Inc. v. L'Oreal S.A., 129 F.3d 588 (Fed. Cir. 1997) 16

Finnigan Corp. v. Int'l Trade Comm'n, 180 F.3d 1354 (Fed. Cir. 1999) 12

Juicy Whip, Inc. v. Orange Bang, Inc., 185 F.3d 1364 (Fed. Cir. 1999) 18

Lough v. Brunswick Corp., 86 F.3d 1113 (Fed. Cir. 1996) 13, 16

Markman v. Westview Instruments, Inc., 52 F.3d 967, 985 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996) 14

Mycogen Plant Science, Inc. v. Monsanto Co., 243 F.3d 1316 (Fed. Cir. 2001) 16

Cited Authorities

Page

Paragon Podiatry Lab., Inc. v. KLM Lab., Inc., 984 F.2d 1182 (Fed. Cir. 1993) 13, 16

Petrolite Corp. v. Baker Hughes, Inc., 96 F.3d 1423 (Fed. Cir. 1996) 13, 16

Pfaff v. Wells Electronics, 525 U.S. 55 (1998) 4, 8, 9, 14, 15, 16, 20, 22, 23

Sinskey v. Pharmacia Ophthalmics, Inc., 982 F.2d 494 (Fed. Cir. 1992) 12, 13, 16

Stiftung v. Renishaw PLC, 945 F.2d 1173 (Fed. Cir. 1991) 19

The Barbed Wire Patent Case, 143 U.S. 275 (1892) 11, 12

The Telephone Cases, 126 U.S. 1 (1888) 20

TP Lab., Inc. v. Professional Positioners, Inc., 724 F.2d 965 (Fed. Cir. 1984) 13

Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368 (Fed. Cir. 1998) 12

Cited Authorities

Page

Statutes:

35 U.S.C. § 101 ..... 17, 18

35 U.S.C. § 102(b) 4, 23

35 U.S.C. § 102(g) 16

35 U.S.C. § 112 ..... 9, 17, 21

STATEMENT OF THE CASE

In December 1990, Petitioner Robotic Vision Systems, Inc. ("RVSI") was building and selling a commercial version of a laser-based inspection machine that inspected integrated circuit ("IC") devices arranged in rows and columns in trays. These trays, containing rows and columns of IC devices, are illustrated in Figure 5 of the patent-in-suit, U.S. Patent No. 5,463,227 (the " '227 patent"), which is reproduced below.

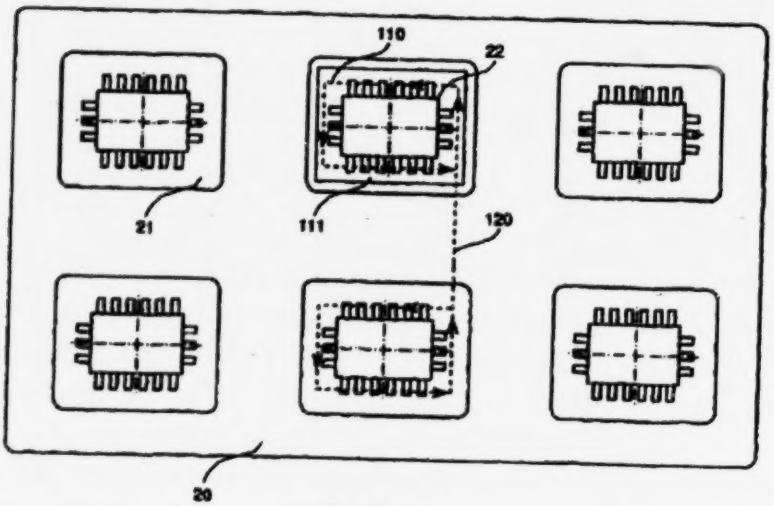

FIG. 5
U.S. Patent No. 5,463,227, A55.

RVSI's machine inspected the devices by scanning a laser beam across the device leads, then analyzing the data to determine if each device met the relevant quality standards. RVSI's commercial machine, called the LS-2000, inspected one device at a time, following the scan path shown above. That is, it scanned all four sides of one IC device before moving to the next device. Because the machine was commercial, it included all of the software needed to operate the machine, scan the devices, and analyze the data collected.

In December, 1990, two RVSI engineers (Howard Stern and William Yonescu) conceived of an improved scan path for the LS-2000. To save time, the scanner would travel along entire rows and columns, rather than around one chip at a time. This new scan path is illustrated in Figures 6 and 7 of the '227 patent, also reproduced below.

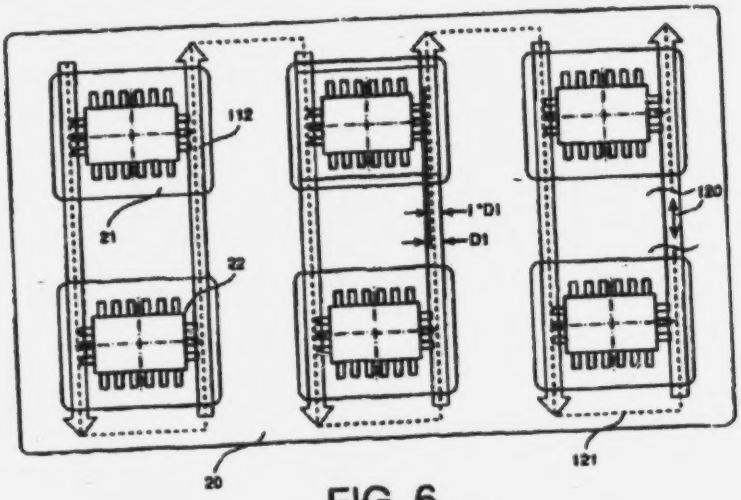

FIG. 6

U.S. Patent No. 5,463,227, A56.

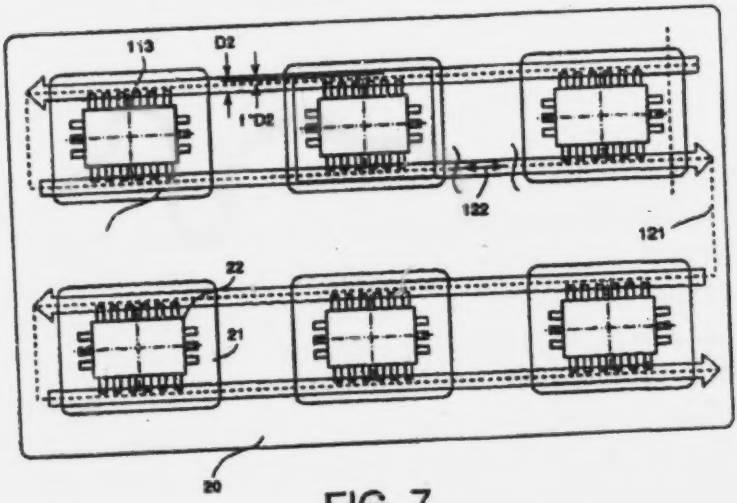

FIG. 7

U.S. Patent No. 5,463,227, A57.

Claim 1 of the '227 patent describes the row/column scan path invention:

> 1. A method for obtaining three-dimensional data from devices having corresponding sides, comprising the steps of: providing a multi-pocketed tray with tray pockets arranged in rows and columns; scanning sequentially with at least one three-dimensional sensor corresponding sides of said devices in a row or column; and repeating said scanning step for all rows and columns containing sides of said devices from which data is to be obtained.

A66.

In response to an interrogatory, RVSI admitted "that the date of conception for claim 1 of the patent-in-suit is December, 1990." A4118. RVSI has called the invention "full tray scanning" or "column and row" scanning. Pet. App. 15a.

On March 14, 1991, Mr. Daryl Lafferty, a representative from RVSI's customer Intel, was visiting RVSI for the purpose of "buying off" an LS-2000 machine. The machine he tested inspected IC devices using the "one-chip-at-a-time" scan path. The district court found that RVSI had previously presented Lafferty "with drawings and descriptions of column and row scanning and explained the method to him, which he understood." Pet. App. 16a. After the March 14 meeting, Lafferty wrote RVSI's Earl Rideout on March 19, 1991 and stated: "Add Full-Tray scan capability, where the scan head moves the full length of the tray on each pass, rather than back and forth over each part." Pet. App. 17a, A4316-A4319. After conferring with RVSI's engineers in March, 1991,

Rideout was not only confident that full-tray scanning would work, he was confident it would work by June 3, 1991. A2456. Accordingly, on March 25, 1991, Rideout promised full-tray scanning to Lafferty by June 3, 1991. Pet. App. 17a, A4321-A4323.

It is undisputed that this exchange constituted a commercial offer of the '227 invention, meeting the first prong of this Court's test for the on-sale bar set forth in *Pfaff v. Wells Electronics*, 525 U.S. 55, 67 (1998).[1] Pet. App. 6a.

RVSI did not need any new hardware to implement the '227 scan path invention. The only thing needed was software. A10962-A10963. In April, inventor William Yonescu described the invention to RVSI programmer Daniel Briceno and asked him to write this new software to implement the invention. Pet. App. 23a-24a. No written description was given. Pet. App. 18a.[2] None was needed. The district court's findings that Briceno is "a person skilled in the art" (Pet. App. 23a), and that Yonescu's "explanation was sufficient for Briceno to understand the method and write the software code to implement the method" (Pet. App. 18a) are not disputed.

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1. Under *Pfaff*, invalidity under the on-sale bar requires two things before the critical date: (1) a commercial offer of the claimed invention, and (2) that the invention is ready for patenting. 525 U.S. at 67. The "critical date" is one year before the filing date of the patent. 35 U.S.C. § 102(b). The application for the '227 patent was filed on June 24, 1992. The critical date is June 24, 1991.

2. Page 18a of the Appendix was typed incorrectly. The district court opinion reads: "Yonescu orally explained full-tray scanning to Briceno." A7.

The new software module written by programmer Briceno was called "full tray mode." A2887-A2888, A4536. (The module for the "one-chip-at-a-time" scanning was called "sequence mode.") *Id.* The "full tray mode" module was completed by May 22, 1991. A2888-A2889. The district court found: "By May 22, 1991, Briceno had developed the code enabling the LS-2000 machine to perform the column and row method. . . ." Pet. App. 18a.

RVSI has never alleged that Briceno, through writing software, made any contribution to the '227 invention. He is not an inventor. A50. On the contrary, although not mentioned by RVSI anywhere to this Court, in an earlier appeal the Federal Circuit agreed with RVSI's assertion that the software needed to practice the '227 invention was within the skill of the art. Pet. App. 15a, 33a.

After May 22, 1991, programmer Briceno began developing software for a third module, for a different RVSI invention that RVSI called "zig zag." Briceno's third module was called "full tray zig zag mode." A2889, A4536. The district court found that "zig-zag attempted to resolve problems resulting from the combination of RVSI's use of a narrow swath on the sensor and shifting of devices in the tray products. . . ." Pet. App. 19a. This "zig zag" improvement invention was described and claimed in another patent, U.S. Patent No. 5,371,375 ("the zig zag patent") and is illustrated in Figure 21 of that patent, reproduced below. As shown below, the scanner "zigs" and "zags" between tray pockets to scan IC devices out of line.

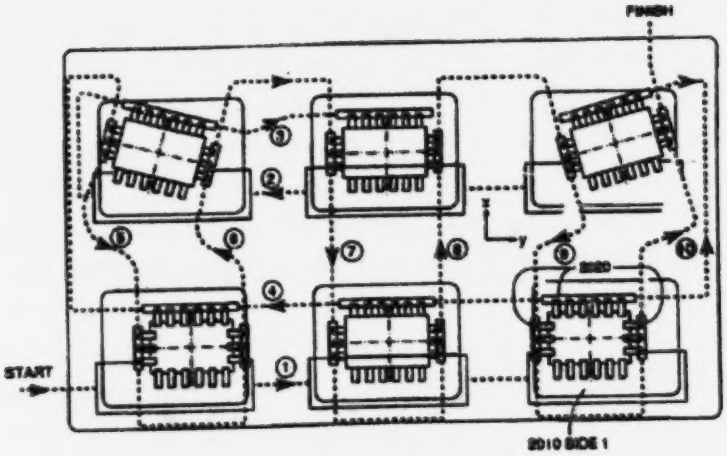

FIG. 21

U.S. Patent No. 5,371,375, A3455.

At trial, RVSI co-inventor Howard Stern submitted a Declaration stating that he did not know whether the full tray scanning invention would work.[3] RVSI offered no documents corroborating Stern's alleged skepticism. RVSI co-inventor William Yonescu, who had previously testified that the software for practicing the '227 invention — the only thing needed to convert the old LS-2000 machines to the patented invention — was within the skill of the art (Pet. App. 33a), did not testify at trial.

After a full trial on these issues, the district court found:

> [T]he invention was ready for patenting between March and April of 1991 when Mr. Yonescu described the invention orally to Mr. Briceno in a manner sufficiently specific to enable a person

3. Because this was a bench trial, Stern's direct examination testimony was submitted by a Declaration.

> skilled in the art (Briceno) to write the software code that enabled the practice of the invention.

Pet App. 23a-24a.

The district court explained the basis for this conclusion in the following fact findings:

> Sometime between March and April of 1991, William Yonescu, a co-inventor of the column and row method, asked Daniel Briceno of [RVSI] to write the software for full-tray scanning. Yonescu [orally][4] explained full-tray scanning to Briceno. This explanation was sufficient for Briceno to understand the method and write the software code to implement the method.

Pet. App. 18a.

The Federal Circuit found that RVSI did not prove that these fact findings were clearly erroneous:

> The district court specifically found that Yonescu's disclosure was made before the critical date and that "[t]his explanation was sufficient for Briceno to understand the method and write the software code to implement the method." *Id.* Because Robotic has not shown that these factual findings are clearly erroneous, we conclude that they support the court's determination that the invention was ready for patenting.

Pet. App. 8a.

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4. *See* footnote 2.

REASONS FOR DENYING THE WRIT

A. The Federal Circuit Correctly Applied The "Ready For Patenting" Test Of *Pfaff*

Under *Pfaff*, invalidity under the on-sale bar requires two things before the critical date: (1) a commercial offer of the claimed invention, and (2) that the invention is ready for patenting. 525 U.S. at 67. In this case, it is undisputed that there was a commercial offer of the claimed invention before the critical date. The only issue is whether the invention was "ready for patenting" before the critical date. (Petitioner's Brief, p. 2 n.2.)

On the requirements for "ready for patenting," this Court stated:

> That condition may be satisfied in at least two ways: by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.

Pfaff, 525 U.S. at 67-68.

The critical date is June 24, 1991. The district court expressly found that in April, 1991, inventor William Yonescu described his invention to programmer Daniel Briceno, a person skilled in the art, in a manner sufficiently specific for Briceno to practice the invention. Pet. App. 18a, 23a. We know this is true because Briceno did it. Briceno wrote software — the only thing that RVSI needed to create to

practice the invention (A10962-A10963) — to practice the invention. He did not need to invent anything. On the contrary, in the first appeal, RVSI avoided invalidity based on failure to disclose the "best mode"[5] by arguing the software for practicing the invention (undisclosed in the '227 patent) was within the ordinary skill of the art. Pet. App. 33a. The Federal Circuit relied on RVSI's representations and reversed the district court's 1996 finding of best mode invalidity, and remanded the case for trial. Pet. App 39a.

It is therefore undeniable that, in the words of this Court, inventor Yonescu in fact gave programmer Briceno "descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention." *Pfaff*, 525 U.S. at 67-68.

The Federal Circuit correctly affirmed the on-sale bar on this basis, holding:

> We agree with View that the claimed invention, including the necessary software for implementing the full-tray scanning method, was ready for patenting prior to the critical date. Sometime between March and April of 1991,

---

5. 35 U.S.C. § 112 states, *inter alia* (emphasis added):

> The specification shall contain a written description of the invention, and of the manner and process of making a using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, *and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

> William Yonescu, a co-inventor of the full-tray scanning method, explained the invention to Daniel Briceno of Robotic and asked him to write the software for full-tray scanning. *Robotic III* at 6. This explanation was sufficiently specific for Briceno to understand the invention and to write the software needed to implement the method. *Id.* Regardless whether or not the software was reduced to practice prior to the critical date, it is undisputed that Briceno ultimately completed the software program pursuant to Yonescu's description of the invention. In *Pfaff*, the Supreme Court, based on the facts of that case, referred to "drawings or other descriptions" as proof that an invention is complete, and hence ready for patenting. In this case, the proof was disclosure to Briceno. Accordingly, because Yonescu's disclosure was sufficiently specific to enable Briceno, a person skilled in the art, to practice the invention, the district court did not err in concluding that the invention was ready for patenting before the critical date.

Pet. App. 7a.

B. RVSI Proposes A Subjective Application Of The "Ready For Patenting" Test That Would Eviscerate The Test And Eliminate The On-Sale Bar As A Defense

Notwithstanding the undisputed facts that inventor Yonescu described the invention to programmer Briceno, and that the description was sufficiently specific for Briceno to practice the invention, RVSI asks this Court to rule that such facts are insufficient merely because Yonescu's co-inventor

Stern testified that he did not know whether the invention would be commercially feasible. RVSI wants a subjective test for the on-sale bar — if a co-inventor is willing to testify that he was not sure the invention would work, even if that testimony lacks any corroboration, there can be no on-sale bar.

This proposed subjective standard would eviscerate this Court's ready for patenting test and the on-sale bar. Such subjective, inventor-testimony based tests have been uniformly rejected by this Court and the Federal Circuit in virtually every context.

Over one hundred years ago, in *The Barbed Wire Patent Case*, 143 U.S. 275, 288-89 (1892), this Court held that testimony of twenty-four allegedly *disinterested* witnesses was *not* sufficient to support a defendant's testimony that he had allegedly made the invention at issue before the plaintiff:

> In view of the unsatisfactory character of testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, courts have not only imposed upon defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory, and beyond a reasonable doubt.
>
> * * *
>
> Witnesses whose memories are prodded by the eagerness of interested parties to elicit

> testimony favorable to themselves are not usually to be depended upon for accurate information.

Barbed-Wire, 143 U.S. at 284.

Here, co-inventor Howard Stern was obviously *interested*. Although the district court did not rely on it, the district court noted doubts about Stern's credibility in a footnote. Pet. App 24a, n.4. Further, co-inventor William Yonescu did not testify, apparently because he did not share the skepticism. On the contrary, early in the proceedings, he testified that the software needed to practice the invention, which was the only thing needed, was within the skill of the art. Pet. App. 33a. RVSI's undisputed early commercialization of the invention also contradicts Mr. Stern's uncorroborated testimony of this skepticism. Finally, Earl Rideout, who sold the machine to Intel in March, 1991, admitted that at the time of his commitment to Intel (March 25, 1991) RVSI's engineers were confident that they could make the invention work, and Rideout was confident they could deliver a commercially acceptable machine by June 3, 1991 — before the critical date of June 24, 1991. A2456.

The Federal Circuit has followed this Court's guidance on uncorroborated oral testimony. *See, e.g., Finnigan Corp. v. Int'l Trade Comm'n*, 180 F.3d 1354, 1366 (Fed. Cir. 1999); *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1372 (Fed. Cir. 1998).

The Federal Circuit has also uniformly rejected an inventor's subjective testimony in the on-sale bar context, and in particular testimony that sales were for "experimental" rather than "commercial" purposes. In *Sinskey v. Pharmacia*

Ophthalmics, Inc., 982 F.2d 494, 499 (Fed. Cir. 1992), the Federal Circuit held:

> Post-hoc affidavit testimony alone, years after the events described and purporting to show an inventor's subjective experimental intent, will never satisfy the burden of establishing experimental use in a case like this where there is no contemporaneous evidence of experimental purpose and the objective evidence is to the contrary. *See Harrington Mfg. Co.*, 815 F.2d at 1481 n.3, 2 USPQ2d at 1366 n. 3.

See also Lough v. Brunswick Corp., 86 F.3d 1113, 1122 (Fed. Cir. 1996) ("[T]he expression by an inventor of his subjective intent to experiment, particularly after institution of litigation, is generally of minimal value."); *Paragon Podiatry Lab., Inc. v. KLM Lab., Inc.*, 984 F.2d 1182, 1186 (Fed. Cir. 1993); *TP Lab., Inc. v. Professional Positioners, Inc.*, 724 F.2d 965, 972 (Fed. Cir. 1984).

The Federal Circuit has recognized that, "[i]f a mere allegation of experimental intent were sufficient, there would rarely if ever be room for summary judgment based on a true 'on-sale' defense under 35 U.S.C. § 102(b)." *Petrolite Corp. v. Baker Hughes, Inc.*, 96 F.3d 1423, 1427 (Fed. Cir. 1996), quoting *D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1150 (Fed. Cir. 1983). RVSI's proposed subjective test would similarly lead to the extinction of the on-sale bar. Paraphrasing *Petrolite*, "[i]f a mere allegation of [skepticism] were sufficient, there would rarely if ever be room for summary judgment based on a true 'on-sale' defense under 35 U.S.C. § 102(b)." *Petrolite*, 96 F.3d at 1427.

Distrust of subjective, litigation induced inventor testimony in the context of claim construction led to the Federal Circuit's opinion in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 985 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996).

RVSI suggests that the Federal Circuit's rejection of the inventor's subjective testimony to defeat the ready for patenting test will lead to uncertainty. (Petitioner's Brief, pp. 3, 13 n.15, 28.) The Federal Circuit's objective application of *Pfaff* — an invention is ready for patenting when an inventor actually describes it to a person skilled in the art and the person actually practices the invention based on the description — is far more certain than RVSI's proposed subjective test based on uncorroborated testimony from a single co-inventor. Further, as this Court noted in *Pfaff*, and the Federal Circuit noted in this case, the timing of a commercial offer for sale "is entirely within the control of the patentee." Pet. App. 10a.

In footnote 21 (Petitioner's Brief, pp. 19-20), RVSI represents that this Court in *Pfaff* endorsed RVSI's subjective, inventor-testimony based standard. RVSI states:

> The *Pfaff* Court acknowledged that inventor skepticism is relevant to the on-sale inquiry, and quoted *Elizabeth v. Pavement Co.*, 97 U.S. 126, 137 (1877), for the following proposition:
>
> > It is sometimes said that an inventor acquires an undue advantage over the public by delaying to take out a patent, inasmuch as he thereby preserves the monopoly to himself for a longer period than is allowed

> by the policy of the law; but this cannot be said with justice when the delay is occasioned by a *bona fide* effort to bring his invention to perfection, or to *ascertain whether it will answer the purpose intended*. His monopoly only continues for the allotted period, in any event; and it is in the interest of the public, as well as himself, that the invention should be perfect and properly tested, before a patent is granted for it.

525 U.S. at 65 (emphasis added [by RVSI]).

RVSI **omits** the following sentence, *emphasized* by this Court in *Pfaff*, from its quote: "*Any attempt to use it for a profit, and not by way of experiment, for a longer period than two years [the "bar" was formerly a two year bar] before the application, would deprive the inventor of his right to a patent.*" *Pfaff*, 525 U.S. at 65, quoting *Elizabeth v. American Nicholson Pavement Co.*, 97 U.S. 126, 137 (1877) (emphasis in original).

More to the point, *Elizabeth* concerns the doctrine of experimental use, which relates to the first prong of the on-sale bar (commercial offer for sale). *Pfaff*, 525 U.S. at 64. ("The law has long recognized the distinction between inventions put to experimental use and products sold commercially.") Under that doctrine, a sale made for experimental, rather than commercial, purposes does not trigger the on-sale bar. *Pfaff*, 525 U.S. at 64-65. RVSI repeatedly told the district court and the Federal Circuit, however, that it was **not** relying on the experimental use doctrine. A4283, A1079. Finally, as mentioned above, even under the experimental use doctrine, courts have long held that litigation induced inventor testimony is not sufficient.

Petrolite, 96 F.3d at 1427; *Lough*, 86 F.3d at 1122; *Paragon*, 984 F.2d at 1186; *Sinskey*, 982 F.2d at 499; *D.L. Auld*, 714 F.2d at 1150. RVSI's statement on page 20 that "the Federal Circuit in this case for the very first time completely ignored an inventor's skepticism regarding the workability of his invention in determining whether an invention is complete and 'on-sale' " (Petitioner's Brief, p. 20) is not true.

RVSI is asking this Court to reverse *Pfaff's* holding that a reduction to practice is **not** required to prove an on-sale bar. 525 U.S. at 66-67. The current Federal Circuit standard for reduction to practice in priority contests under 35 U.S.C. § 102(g) is that "a reduction to practice does not occur until the inventor has determined that the invention will work for its intended purpose." *Estee Lauder Inc. v. L'Oreal S.A.*, 129 F.3d 588, 593 (Fed. Cir. 1997); *See also, e.g., Mycogen Plant Science, Inc. v. Monsanto Co.*, 243 F.3d 1316, 1335 (Fed. Cir. 2001); *Eaton v. Evans*, 204 F.3d 1094, 1097 (Fed. Cir. 2000). RVSI argues on page 11 that an invention cannot be ready for patenting until the "inventor [is] satisfied that his invention will work for its intended purpose. . . ." (Petitioner's Brief, p. 11.)

There is no principled reason to adopt a subjective standard for the on-sale bar that would allow an inventor to avoid the on-sale bar merely by testifying that he was unsure, at the time of an early commercialization of the invention, that the invention would work for its intended purpose.

As the Federal Circuit stated:

> Robotic contends that Yonescu's disclosure to Briceno was not a disclosure of the claimed invention, as it demonstrated that more work was

> needed to determine whether the invention would work for its intended purpose. We disagree. . . . Focusing on the statutory language of § 102(b), the Court interpreted the term "invention" as requiring a complete *conception*. *Id.* at 66, 48 USPQ2d at 1646 ("The word 'invention' must refer to a *concept* that is complete, rather than merely one that is 'substantially complete.' " (emphasis added)). Notably absent from this test is a requirement that an inventor have complete confidence that his invention will work for its intended purpose. Such confidence often must await a reduction to practice, which is a separate basis on which an invention may be shown to be ready for patenting.

Pet. App. 8a-9a.

C. RVSI's Arguments In Support Of A Subjective, Inventor-Testimony Based Standard For "Ready For Patenting" Are Not Supported By The Law Nor The Record

RVSI offers two main arguments in support of its proposed inventor-testimony based standard for the on-sale bar. RVSI argues first, on pages 14-22, that the subjective standard follows from the utility requirement. 35 U.S.C. § 101. RVSI argues second, on pages 22-29, that the subjective standard follows from the enablement requirement. 35 U.S.C. § 112. Neither of these statutory sections provide any legal support for RVSI's position that a single co-inventor's unsupported testimony on alleged skepticism avoids the on-sale bar. Further, RVSI's arguments to this Court are based on unsupported factual assertions that View does not accept.

1. The Federal Circuit's Rejection Of One Co-Inventor's Unsupported Testimony On Skepticism Does Not Conflict With The Utility Requirement

On pages 14-22 of its Petition, RVSI argues that 35 U.S.C. § 101 (requiring that inventions be "useful") mandates that a co-inventor's litigation testimony of skepticism bars a ready for patenting finding.

There is no connection between the utility requirement and RVSI's subjective, inventor-testimony based on-sale bar standard. An invention has "utility" if it provides any identifiable benefit:

> An invention is "useful" under section 101 if it is capable of providing some identifiable benefit. *See Brenner v. Manson*, 383 U.S. 519, 534, 86 S.Ct. 1033, 16 L.Ed.2d 69 (1966); *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed. Cir. 1992) ("To violate § 101 the claimed device must be totally incapable of achieving a useful result"); *Fuller v. Berger*, 120 F. 274, 275 (7th Cir. 1903) (test for utility is whether invention "is incapable of serving any beneficial end").

Juicy Whip, Inc. v. Orange Bang, Inc., 185 F.3d 1364, 1366 (Fed. Cir. 1999).

The invention need not meet all of the inventor's objectives, and need not even be the best way to accomplish the inventor's objectives:

> To meet the utility requirement, the Supreme Court has held that a new product or process must be shown to be "operable" — that is, it must be

> "capable of being used to effect the object proposed." *Mitchell v. Tilghman*, 86 U.S. (19 Wall.) 287, 396, 22 L.Ed. 125 (1873). Our cases have not, however, interpreted this language in *Mitchell* to mean that a patented device must accomplish *all* objectives stated in the specification. On the contrary, "[w]hen a properly claimed invention meets at least one stated objective, utility under § 101 is clearly shown." *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 958, 220 USPQ 592, 598 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835, 105 S.Ct. 127, 83 L.Ed.2d 69 (1984). The utility requirement, though an essential requisite of patentability, has other limits. An invention need not be the best or the only way to accomplish a certain result, and it need only be useful to some extent and in certain applications: "[T]he fact that an invention has only limited utility and is only operable in certain applications is not grounds for finding lack of utility." *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 762, 221 USPQ 473, 480 (Fed. Cir. 1984). Whether an invention claimed in a patent lacks utility is a question of fact, which we therefore review for clear error. *Raytheon*, 724 F.2d at 956, 220 USPQ at 596.

Stiftung v. Renishaw PLC, 945 F.2d 1173, 1180 (Fed. Cir. 1991).

RVSI has never disputed that the RVSI invention could inspect IC devices. Thus, it is undisputed that **at conception** this invention had utility — inspecting IC devices — and RVSI knew it. Even if one accepts Mr. Stern's unsupported

testimony on skepticism, the skepticism concerned only whether RVSI's invention would generate commercially acceptable accuracy. There was never any doubt that the invention was "capable of providing some identifiable benefit" — meeting the utility requirement.

Pfaff itself reveals that "ready for patenting" does not require freedom from all skepticism. The principal precedent discussed in *Pfaff* was *The Telephone Cases*, 126 U.S. 1, 535-536. 525 U.S. at 61-63. There, this Court held that Alexander Graham Bell was entitled to a patent on his invention even though he had not reduced the invention to practice. With all due respect to RVSI's invention, it is not the telephone. If there was any invention that required a reduction to practice before all skepticism was removed, it was the telephone. If the telephone was ready for patenting before it was reduced to practice, RVSI's new scan path surely was as well.

As the Federal Circuit stated in this case, "[i]t will be a rare case indeed in which an inventor has no uncertainty concerning the workability of his invention before he has reduced it to practice." Pet. App. 9a-10a. There is no utility law supporting RVSI's suggestion that an invention must be free from doubt, *i.e.*, reduced to practice, before it is ready for patenting.

2. The Federal Circuit's Rejection Of One Co-Inventor's Unsupported Testimony On Skepticism Does Not Conflict With The Enablement Requirement

RVSI's second argument for its subjective, inventor-testimony based standard, is that the Federal Circuit ignored the enablement requirement of 35 U.S.C. § 112.[6] RVSI argues in particular that it could not have met the enablement standard at the time of the critical date because it was still developing the invention. (Petitioner's Brief, p. 23.)

The problem with RVSI's "enablement" argument is that no **evidence** supports its contention that it was developing the **invention**. On page 23, RVSI describes a litany of alleged development — without any citation to the record. RVSI also fails to tie any of this alleged development with the claimed invention. (Petitioner's Brief, p. 23.)

On the contrary, in RVSI's own words, RVSI was developing "details" relating to the LS-2000, its commercial embodiment of the invention. (Petitioner's Brief, p. 23.) There is no support for the proposition that development of unclaimed, undisclosed "details" prevents an invention from

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6. Section 112 states, *inter alia* (emphasis added):

> The specification shall contain a written description of the invention, and of the manner and process of making a using it, in such full, clear, concise, and exact terms as to *enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same,* and shall set forth the best mode contemplated by the inventor of carrying out his invention.

being "ready for patenting." If it did an on-sale bar would surely almost never arise. It would arise only if every detail in the commercial product and in the patent specification was completed more than one year before filing — an actual reduction to practice not only of the invention, but also all details of the commercial embodiment. The need for an actual reduction to practice was specifically rejected in *Pfaff*. 525 U.S. at 66-67.

The district court found, and the record reveals, that all work being done was directed toward other aspects of the LS-2000, and developing software for a different invention ("zig zag"), claimed in a different patent (the "zig zag" patent). Pet. App. 19a; A2889, A4536. RVSI's trial proofs were that "zig-zig" functionality had to be added to the '227 method before RVSI could make it work. Regarding "zig-zag," the district court found:

> The concepts of intelligent scanning and zig-zag attempted to resolve problems resulting from the combination of RVSI's use of a narrow swath on the sensor and the shifting of devices in the tray pockets either prior to or during scanning. [Citations omitted.] "Zig-zag is not part of [the '227] invention," and neither it nor intelligent scan is disclosed in the '227 patent.

Pet. App. 19a.

RVSI also argues that the Federal Circuit's rejection of RVSI's skepticism and alleged subsequent development of these "details," is "tantamount to holding that disclosure of the conception suffices to satisfy the ready for patenting test." (Petitioner's Brief, p. 23.) In *Pfaff* this Court clarified that

the word "invention" refers to "conception." 525 U.S. at 66. Here, it is undisputed that the conception was complete before the critical date (A4118), and RVSI offered no evidence of any development of the invention, only commercial "details," after the critical date. As expressly contemplated in footnote 14 of *Pfaff*, RVSI's complete conception/invention proves it was ready for patenting. *Pfaff*, 525 U.S. at 68, n.14.

The '227 invention was complete, and therefore ready for patenting, long before the critical date.

CONCLUSION

The Federal Circuit correctly applied *Pfaff* in holding that the district court was not clearly erroneous in finding that the invention of claim 1 of the '227 patent was "ready for patenting" before the June 24, 1991 critical date, invalidating the claim under 35 U.S.C. § 102(b).

Respectfully submitted,

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